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IN THE

Supreme Court of the United States

OCTOBER TERM, 1953

No. 341

WHITE CAP COMPANY,
Petitioner,

vs.

OWENS-ILLINOIS GLASS COMPANY,
Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT AND BRIEF IN SUPPORT THEREOF

WILLIAM H. DAVIS,
GEORGE E. FAITHFULL,
CYRUS S. HAPGOOD,
RAYMOND L. GREIST,
PAUL PLUNKETT,
Attorneys for Petitioner.

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IN THE

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WHITE CAP COMPANY,

Petitioner,

v.

OWENS-ILLINOIS GLASS COMPANY,

Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT

TO THE HONORABLE THE CHIEF JUSTICE AND ASSOCIATE JUSTICES OF THE SUPREME COURT OF THE UNITED STATES:

Your petitioner, White Cap Company, respectfully prays that a writ of certiorari issue to the United States Court of Appeals for the Sixth Circuit to review a judgment of that court entered April 24, 1953. A certified transcript of record, including the proceedings in the said Circuit Court of Appeals, has been filed herein pursuant to Rule 38.

Summary Statement of the Matter Involved

The Court of Appeals, affirming the District Court, held petitioner's patent* invalid for want of invention.

Suit was brought by petitioner against respondent for infringement, in the United States District Court for the Northern District of Ohio, Western Division. On consent, the District Court under Rule 53 ordered reference to a Special Master on September 10, 1947. On February 16, 1951, the Master filed his report (II, 601-761). He found the patented closure cap novel but recommended dismissal on the ground that the patent was invalid for want of invention. He rested this conclusion on the decision of this Court, on December 4, 1950, in the *A & P* case** (II, 649-652); or, as he said, if he had "erred in the application of the test set out" in that case, then on the standard, as he understood it, applied by this Court in the *Tri-Ergon* case*** (II, 652-3).

The District Court approved and adopted the Master's findings and entered judgment dismissing the complaint, having in mind, as the District Judge (Kloeb) said (II, 775):

> "the provisions of Rule 53(e)(2) of the Federal Rules of Civil Procedure, which reads in part as follows:
> 'In an action to be tried without a jury the Court shall accept the Master's findings of fact unless clearly erroneous, * * *'."

The Court of Appeals affirmed, saying (II, 790):

> "The master found, and plaintiff concedes, that all elements in the claims of the patent in suit were old at

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* Patent 2,339,827 for "Closure Cap and Package", granted to petitioner, assignee of William P. White, January 25, 1944 (III, 1).

** *The Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp.*, 340 U. S. 147.

*** *Altoona Publix Theatres, Inc.* v. *American Tri-Ergon Corp.*, 294 U. S. 477 (1935).

the time of conception. The master also found that each element performed the same mechanical function in the combination that it performed in the past outside of the combination, that the claimed invention involved no new principle not found in the prior art, and required no more than mechanical skill. These are findings of fact which were approved by the District Court. Unless clearly erroneous this court must accept them."

The Court of Appeals found error in and set aside the Master's consideration, as part of the prior art, of certain experimental work on closure caps carried on by the research engineers of Armstrong Cork Company but not made public prior to the patentee's conception. It concluded, however, that this error did not affect the soundness of the Master's holding on lack of invention because of other patents and practices besides that of Armstrong (II, 790-1).

It is petitioner's submission that the errors that are significant on this petition,—that is, the errors apart from what we regard as the error in result, which we do not press as a ground in itself for the writ sought—were two errors in the manner of adjudication of a patent for a purported new combination.

It is the ground of the petition that the correction of these errors is of sufficient importance to the administration of the patent law to warrant the exercise of this Court's discretionary power of review. Incident to that, we believe that a correction of those errors would lead, in this case, to a judgment that the White patent is valid, for in all other respects the findings below mark it as a valid patent.

The two presently significant errors of the Court of Appeals were these. First, it failed to distinguish between those findings of the Master which are at the level

of objective fact and are properly given the force provided in Rule 52(a), and those other findings of a conclusory nature, on the ultimate issue of patentability, which involve a subjective element and an application of judicially established criteria, whether they be regarded as conclusions of fact or as mixed law and fact. Second, the Court of Appeals erred in taking it that the Master had found that the claimed invention "involved no new principle not found in the prior art", and in taking what the Master did find in reference to a "principle" as being a finding that the patented combination does not have that new mode of action or functional relationship among its constituent elements that is at times called a principle. The fact is that one of the Master's basic errors was the failure to make a finding on that subject. Had the Court of Appeals not accorded to the conclusory finding—that the "claimed invention * * * required no more than mechanical skill"—the force of a finding subject to Rule 52(a), its independent review of that conclusion could not have failed to reveal the Master's omission to make a finding on the matter of objective fact that is the vital factual predicate for a determination of that ultimate issue under the governing decisions of this Court.

The Master's basic error of omission was related to his misapplication of the established judicial criteria of patentability; and particularly his misapplication of this Court's rulings in the *A & P* case and the *Tri-Ergon* case. His omission was that he made no finding of objective fact as to the existence or not, within the patented concert of elements, of a new principle, in the sense of a new mode of operation or a new functional relationship. The Master came very close to that in his finding that the prior art did not disclose the patented combination and that it had not been established that any of the prior devices "will perform substantially the same work in substantially the same way" (II, 742, Finding B 1-a). But

in attacking the ultimate question of patentability, in ostensible adherance to the criteria established in the *A & P* case and the *Tri-Ergon* case, the Master did not proceed with that as his premise of fact, or with any regard to the functional relationship or mode of operation of the patented concert of elements. He so interpreted those decisions, erroneously, as to think it needless to do so.

At the level of objective fact, the Master was correct in finding that each element of the patented combination was old, and that each element performed the same mechanical function in the combination that it performed in the past outside the combination (II, 651-2). And the Court of Appeals was correct in accepting those findings, since they are of the sort properly within the meaning of Rule 52(a). But the Master omitted the vital step (and the Court did not note the omission, because it erroneously thought he had found no new principle) in not going on to find whether or not, in the combination, those old elements coacted in a new way, in addition to performing their respective usual functions. The Master took it that the decisions of this Court which he purported to follow require only a consideration of the individual functions of the several elements, in and out of the combination; whereas it is almost necessarily true that the *individual* functions of the elements of a combination commonly are the same as they are outside the combination, and the critical matter always is whether or not *in addition* they take on some united action which vitalizes the new assemblage and marks it as an entity having an organic law and principle of its own.

Because the Master made no finding on that critical matter, and reached a conclusion of unpatentability in its absence; and because the Court of Appeals took it that he had made such a finding, and moreover gave his conclusion on the ultimate issue the force of a finding

subject to Rule 52(a), the result has been that the true and inherent question of patentability has not been adjudicated by either the Master or the Court of Appeals. A proper manner of adjudication would start with a finding of truly objective fact by the Master concerning this critical matter of the principle or organic law of action of the patented combination; and would then proceed, upon appeal, with that finding accepted unless clearly erroneous (Rule 52(a)), but with the ultimate conclusion of patentability, involving the subjective factor, open to review as to the proper application of judicially established criteria, without the fetter of Rule 52(a). Only in that way can the trial courts and the appellate courts properly exercise their respective roles in the adjudication of the many patents which present this problem of the patentability of putative combinations of old elements.

There was also a further error, no doubt insufficient in itself to warrant review in this Court, but related to and illustrative of the need for clarification of the role of findings in the appellate review of cases of this sort. Having corrected the Master's error of counting the Armstrong experiment as a part of the prior art, the Court of Appeals then had to consider the conclusion of unpatentability in the light of the true prior art evidence. In doing so, it departed materially from the Master's findings of objective fact concerning the prior patents that then figured, without even purporting to hold these findings clearly erroneous. It was, as we believe, an error of oversight induced at least in part by the undue weight given to the Master's conclusory finding of unpatentability. Again, a proper review in which that conclusory finding was examined without the fetter of Rule 52(a) would have led to a more careful consideration and use of the findings about the prior art that were entitled to be accepted under Rule 52(a) unless shown to be clearly erroneous.

Jurisdiction

The jurisdiction of this Court is invoked under 28 U. S. C. 1254. The date of the judgment of the Court of Appeals which petitioner seeks to have reviewed is April 24, 1953 (II, 787). A seasonably filed petition for rehearing was denied by the Court of Appeals on June 16, 1953 (II, 829).

Questions Presented

1. Is the question whether the quality of invention exists in a novel conjunction or concert of known elements properly adjudicated when there is no finding of fact as to, or any express recognition of, the principle (mode of operation, functional relation or organic law) that governs the patented concert of elements?

2. Is the question of patentable invention a finding of fact of the sort reviewable only for clear error under Rule 52(a) or is it a question of law, or the sort of fact inference, that is subject to unrestricted review on appeal?

Reasons Relied On for Allowance of the Writ

A. The importance, to the effective administration of the patent law, that this Court should definitively round out, to embrace affirmative as well as negative cases, its warning in the *A & P* case that patent claims for novel conjunctions of old elements should be scrutinized in the light of the test whether the elements have taken on some new quality or function from being brought into concert, so that the whole in some way exceeds the sum of its parts.

B. The importance of a resolution by this Court of the now existing judicial conflict and confusion as to whether,

and what part of, the question of patentable invention is, in such cases, a question of fact of the sort reviewable only for clear error, or is a question of law, or the sort of fact inference, that is subject to unrestricted review on appeal.

C. The importance, in the orderly application of the patent law to claims for novel associations of old elements, of requiring in all such cases a finding of fact by the trial court as to the principle of the patented device and whether its constituent elements do or do not perform any additional or different function in the combination than they perform out of it.

Wherefore it is respectfully submitted that this petition for a writ of certiorari to the Circuit Court of Appeals for the Sixth Circuit should be granted.

William Hammatt Davis,
George E. Faithfull,
Cyrus S. Hapgood,
John Hoxie,
Raymond L. Greist,
Paul Plunkett,
Attorneys for Petitioner.

BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI

Opinions of the Courts Below

The report of the Special Master appears on pages 601-760 of Volume II of the record, and the District Court's memorandum confirming the Master's report on page 775 of the same volume. They are unreported. The opinion of the Court of Appeals for the Sixth Circuit is reported in 203 F. 2d 694 and appears at pages 788-796 of Volume II of the record.

Jurisdiction

The grounds are set forth in the petition.

Statement of the Case

We supplement the statement in the petition of the subject matter involved by a statement of the character and mode of operation of the patented closure cap because it is essential to an appreciation of the first question raised by the petition and of the significance of the reasons advanced for allowance of the writ.

The Patented Closure Cap

The patented closure cap is of the press-on side-seal friction-held type. It is capable of hermetic sealing simply by pressing the cap downwardly over the vessel's mouth, and it can be removed without injury and replaced to renew the air-tight seal. No vacuum is required. This quality of press-on caps—that they be capable of effecting

the initial air-tight closure and of renewing it after removal and replacement—imposes unique and rigid limitations. Reliance on the older expedients of reduced pressure within the package (vacuum sealing) or on mechanically forcing the sealing gasket against the container by deforming the metal side wall of the cap (chucking),* to effect an hermetic seal, are precluded. For air-tight sealing and resealing, the press-on closure must rely wholly on (1) the sealing quality of the gasket itself and (2) the resilient pressure of the metal cap forcing the gasket against the glass surface of the vessel. Consequently, enhancement of the effectiveness of these two forces becomes of critical importance. The question of patentable invention presented in this case hinges on the way the patentee made maximum use of these limited forces.

Its Structure

The patented cap which makes use of these two forces consists of three elements of a very particular structural form and arrangement (see Figs. 3-5 of patent, III, 1). These are (1) a so-called "waist-line" form of shell—one having a constricting waistline at the junction of its cap-like portion and its resilient downwardly flaring skirt; (2) a rubber *sleeve*** gasket *pre-compressed, i. e.,* "of size to receive the sealing surface of the vessel without distention but having its upper end portion circumferentially compressed and contracted within the constricting portion" of the shell, and (3) means by which the gasket of this particular kind and state of pre-compression is locked in the shell, with the dimensions of shell and gasket so chosen that, when fastened in the shell, the gasket will

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* See Master's Report, II, 603-4.

** A "sleeve" gasket is one that extends upwardly, as distinguished from the "disc" or "washer" type which extends horizontally inwardly toward the outer wall of the vessel and is bent sharply upwards and stretched when in place on the vessel.

have "its upper terminus located closely adjacent the lower limit of the constricting portion in position to be further compressed in radial directions between the lower part of the constricting portion and the cylindrical sealing surface of the vessel along only a narrow circumferential sealing zone spaced from the top of the shell * * *" (III, 5, col. 1, 69-73, and 6, col. 1, 4-11).

Its New Mode of Operation or "Principle"

The cap is applied by pressing it downwardly over the vessel's mouth, until it is seated by engagement of the top of the shell with the top rim of the vessel (III, 1, Fig. 4). When thus applied, the upper portion of the gasket makes contact over a sealing zone around the vessel's mouth within the constricting part of the shell. Due to the inter-lock between the gasket and shell, this sealing portion of the gasket is prevented from rising to the top of the cap to be crowded into the space between the upper side wall and top of the cap and the upper portion of the vessel as in the old White free-gasket caps.* Instead, it remains confined to a narrow circumferential sealing zone adjacent the lower limit of the constricting portion of the shell, whereby the full resiliency of the waist-line of the shell is preserved and concentrated in a radially-directed constricting pressure, in contrast to the free-gasket caps (see arrow, fig. 4, III, 1; and III, 4, col. 2, 58-75, and 5, col. 1, 1-9). Also is molded, unstretched, in its precompressed condition despite the action of the entering vessel-mouth in expanding it against the constricting waist-line, because the latter holds it to less than the size at which it can receive the sealing surface of the vessel without distension (III, 4, col. 1, 41-62). Consequently, the sealing zone of the gasket does not become porous due to stretching but is compacted very closely against the glass wall of the vessel by the straight-angle pressure of the shell's

* These earlier caps are shown at II, 605.

waist-line, causing the gasket "to mold into the irregularities of" that wall of the glass "and effect a very strong frictional engagement with the vessel and form a very tight hermetic seal", as described in the patent (III, 4, col. 2, 48-58).

The closure cap of the patent is one of those assemblies of cooperating elements—and other examples are not absent in the history of the patent law*—in which the unique quality specified for each item in form, material, proportions and arrangement is essential to the new mode of operation. Alteration or substitution of any element breaks the organic law that governs their association and destroys the unique quality of their combination. Only when the locked-in precompressed sleeve gasket and the waist-line shell are dimensionally related as described and as defined in the claims is the full resiliency of the waist-line made available to be concentrated upon the narrow circumferential sealing zone of the precompressed gasket. It is not the idea of a narrow sealing zone in itself, but this particular structural combination that generates an effective seal in a narrow zone. It is the location of this narrow sealing zone of action of the gasket "closely adjacent the lower limit of the constricting portion * * * and spaced from the top of the shell" that fully preserves and radially directs the constricting pressure of the shell's waist-line; and it is only because the gasket is precompressed and thus unstretched that this concentrated pressure on a narrow sealing zone molds it into the irregularities of the surface of the glass to "effect a very strong frictional engagement with the vessel and form a very tight hermetic seal."

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* *Cf.* The Grant hard rubber tire assembly held to be patentable invention in *Diamond* v. *Consolidated*, 220 U. S. 429, 433-4; and as *The Barbed Wire Patent* (143 U. S. 275, 282-4) validated under the so-called "last step" rule.

It is this new principle (organic law or functional relationship) that characterizes and gives life to the patented lock-in-gasket cap, and accounts for its improved sealing qualities and an enlarged range of useful availability. Absent the precompression of the gasket, its narrow sealing zone cannot be molded into the irregularities of the glass to form the improved seal, due to the lack of sufficient density of the stretched rubber.* And without the narrow sealing zone spaced from the top, the precompression of the gasket cannot provide the improved seal because the resiliency of the shell is not otherwise made fully available for the constricting pressure and is not directed radially, as described in the patent (III, 4, col. 2, 37-75, and 5, col. 1, 1-9). These effects concur only because it is a precompressed and unstretched sleeve gasket, is locked in the shell of the prescribed kind, and has the particular physical and dimensional relation to the stated parts of the shell. No science could foretell that that most particular structure would develop the sufficient sealing and re-sealing force. It is a wholly empirical thing which turns out to be able to do the job better than any other press-on cap.

The precise question of this new mode of operation and result was passed upon by the Board of Appeals in the Patent Office. The Patent Office Board of Appeals had before it an affidavit of Mr. Williams (File Wrapper, P. Ex. pp. 26, *et seq.*), reaffirmed at the trial, in which he compared the patented locked-in gasket cap with the earlier White free-gasket cap and explained how by virtue of the differences between them the operation and performance of the locked-in-gasket cap is "quite dis-

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* The Armstrong experiments confirm this in showing that when the narrow zone is formed by a disc gasket (stretched by intrusion of the vessel's mouth), the sealing qualities are not even as good as those of the old White free-gasket caps (Master's Report, paragraph 90, II, 643).

tinctly different from the operation and performance of the free-gasket cap." The Master considered and gave full credit to Mr. Williams' affidavit (II, 606[8]), finding that the tests, repeated at the trial, "indicate a difference in the performance of the free-gasket closure and the closure of the patent in suit that has not been controverted by any tests or evidence as to the performance characteristics of the free-gasket closure offered by defendant" (II, 634-5[73]).

The Nature of Its New Accomplishment

The technological advance of the new form of press-on cap was that it extended the availability of the cap into fields where the old free-gasket cap could not be used. Petitioner, White Cap Company, was the pioneer in the introduction into the useful arts and commerce of press-on caps. When it entered the field in 1926, no press-on caps were available. As first introduced, the press-on caps were of the "free gasket" type of White's patent 1,590,787 of 1926, subsequently somewhat improved, in his patent 1,807,187 of 1931. These "free-gasket" press-on closures served with satisfaction in sealing and resealing packages of food products which did not, because of complicating qualities, present special sealing difficulties; and in the ten or twelve years following their introduction in 1926 they captured a large market. But with some products (peanut butter, brine pickles and catsup are examples) which would cause the gasket to become slippery or to swell, these "free-gasket" closures would not serve; the closure would "pump-off", i. e. move up on the neck of the container and break the seal. The consequence was that the caps were usable with only a part of the products of the packers, not with the whole pack, and the "free-gasket" caps acquired "a reputation of limitations".

These limitations were completely overcome with the introduction in 1938 (I, 187-8) of the closure caps of the

patent in suit (I, 54, 55). The evidence on this was summarized by the Master (see II, 604, 605, 665) and stands uncontradicted.

Specification of Errors to Be Urged

The Court of Appeals erred:

(1) In affirming the judgment of the District Court that the patented closure cap lacks invention.

(2) In failing to correct the error of the District Court in approving and adopting as a finding of fact the Master's holding of lack of invention, and in failing to correct the Master's erroneous application of relevant criteria of invention.

(3) In adjudging the question in the absence of any finding of fact as to whether the novel association of elements in the patented closure cap did or did not embody a new principle, and without itself passing on that factual question.

Summary of Argument

The points of argument will follow the reasons relied on for the allowance of the writ and will conclude with a brief discussion of the fact findings of the Court of Appeals' opinion following its rejection of the Master's consideration of the Armstrong experiments on the issue of invention.

ARGUMENT

A. The importance, for the effective administration of the patent law, that this Court should definitively round out, to embrace affirmative as well as negative cases, its warning in the *A & P* case that patent claims for novel conjunctions of old elements should be scrutinized in light of the test whether the elements have taken on some new quality or function from being brought into concert, so that the whole in some way exceeds the sum of its parts.

It is petitioner's submission that the deleterious effect of adjudicating the question of invention in cases involving novel associations of old elements without findings of fact as to whether or not the old elements which make up the patented device perform any *additional* or *different* function in the combination than they perform out of it, is as sharply evident where (as in the instant case) the old elements in combination *do* perform additional or different functions according to a novel principle or organic law of association, as it was in the *A & P* case where they did not.

The time-honored and correct judicial procedure in such cases, thoroughly tested over a century and a half of experience, calls for direct facing of that basic factual question before turning to the evidence of prior knowledge against which the question of invention is to be tested; and this judicial procedure is just as important when there *is* a novel functional relation of the parts as when there is not. Only in this way, in either case, can any reasonably objective judgment be reached as to whether the issued patent does or does not "subtract from former resources freely available to skilled artisans" (*A & P* case, 340 U. S. at p. 152). In the instant case there was no express finding on that basic factual question by the Master, by the District Court, or by the Court of Appeals.

How the Master Erred in His Application of Judicially Established Criteria to the Question of Invention Presented by the Novel Concert of Elements.*

The A & P case: Shortly before the Master made his report this Court decided the *A & P* case. The Master undertook to apply the test laid down in that case to the facts in this case (II, 651-2).

Intending to follow this Court's injunction, to find whether "old elements which made up this device perform any additional or different function in the combination than they perform out of it" (340 U. S. at p. 152), the Master found that, "as in prior art closures", the shell "serves to receive the gasket" and the "resilient metal reacts to compress the gasket against the sealing surface of the container, when the closure is pressed in place"; that the gasket serves as a sealing medium, and that the turned-in lower edge of the shell skirt locks the gasket in place.

The error in this was one of over generalization which caused the Master to overlook or ignore the specific additional actions that are set up within this particular combination.

In this generalized sense, each element does, of course, perform in the patented combination the same function that it performs out of it.** But the remainder of the

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* The Master's views on invention are expressed in paragraphs 102-106, of his report, II 651-654.

** That this is necessarily so, and that its observation is only the first step in the application of this time-honored guiding test, see the comprehensive and dispositive opinion of Judge Dallas (C. C. A. 3) in *National Cash Register* v. *American Cash Register*, 53 Fed. 367; 371-2 (1892); and also *Neill* v. *Kinney* (C. C. A. 3, opinion by Judge Wooley), 239 Fed. 309, 313; *Abbott* v. *Universal* (C. C. A. 1, opinion by Judge Woodbury), 137 F. 2d 166, 168, and *Autosales* v. *Caille Bros.* (C. C. A. 6, opinion by Judge Warrington), 224 Fed. 473, 475-6.

question is whether, *additionally,* in conjunction with the other elements of the novel assembly, it contributes to the performance of new and useful functions according to a new organic law or principle; whether it has that "something which is the law of its organization and function, and raises it above a mere aggregation of elements to a patentable combination" (*Diamond* v. *Consolidated,* 220 U. S. 428, 443); whether the novel conjunction adds to the sum of useful knowledge by contributing something in which "the whole exceeds the sum of the parts"; whether the elements "take on some new quality or function from being brought into contact" (*A & P* case, 340 U. S. at p. 152).

The Master did not ask or answer that remainder of the question, presumably because he thought it needless to do so. Indeed, he did not include in his otherwise full findings of fact any express finding as to the mode of operation or organic law of the conjunction of elements in the patented closure cap. It must be assumed that the Master had some kind of concept of the mode of operation of the patented combination, since on the question of novelty he had, after close examination of each of the many prior patents and procedures brought to his attention, found as to each one of them that on the evidence submitted it had not been established that the prior device "would accomplish the same result as does the closure of the patent in suit, in substantially the same way" (II, 615-647 and Finding 1a, II, 742); but his omission to make any finding as to what that "substantially the same way" was, left him without that clarity of understanding of the mode of operation of the conjunction of elements under examination which is essential to the application of the *A & P* criterion.

In the remainder of his intended application of that test his attention was diverted from the objective question of additional functions in the new organization to the consideration of other partial conjunctions or sub-combinations

of like elements, particulary the caps of the Armstrong unpublished experiments. He went from there directly to the ultimate subjective determination of the question of invention, leaving a gap at the most crucial point.

The main point of this petition is that, for the orderly and reliable administration of the patent law the objective test of the *A & P* case must *precede* the more subjective judgment as to whether the novel combination displays the quality of invention. The first question is in the strictest sense a question of fact subject to review only within the limits of Rule 52 (a); the second, we submit, lies outside the reasonable bounds of that rule and should be subject to unrestricted review.

In the instant case it is clear that the Master's thoughts and conclusions on inventions were vitally affected by the fact that he erroneously considered the unpublished Armstrong experiments as part of the knowledge of the prior art; an error that the Court of Appeals subsequently disapproved.* At this point, however, we are not concerned with any ultimate weighing by the Master of evidence, pro and con, on the subjective question of sufficiency of invention, but rather with his failure to complete the objective examination of the organic principle and mode of functional operation of the patented closure cap.

It is reasonable to assume that the Master's frustrating diversion from the completion of that analysis to premature consideration of the relevancy of Armstrong on the ultimate subject of invention, was due to the fact that he thought of Armstrong as an embodiment of the "principle"

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* Furthermore, as a matter of fact, the Armstrong experiments, which attempted to produce a closure cap "equivalent in vacuum retention and product resistance" to the old White "free-gasket" caps, resulted in a closure which was *inferior* even to the old White caps (Master's Report, paragraph 90, II, 643).

of the patent in suit. That erroneous thinking is clearly expressed in his following attempt to apply the test set up by this Court in the *Tri-Ergon* case (*Altoona Publix Theatres, Inc.*, v. *American Tri-Ergon Corp.*, 294 U. S. 447 (1935)), to the facts in this case.

The Tri-Ergon case:—With the remark "If we have erred in our application of the test set out by the Supreme Court in the *Great Atlantic & Pacific* case", the Master turned from the *A & P* case to the *Tri-Ergon* case and to this Court's ruling, in that case, that the bringing together of old elements in a mechanism "involving no new principle, to produce an old result" is not invention (II, 652-3, par. 105).

The decision in the *Tri-Ergon* case rested on the same rule of the patent law as the decision in the *A & P* case—absence of any additional or different function of the elements in the combination than out of it. The two cases are particular applications of the rule in the stove case, *Hailes* v. *Van Wormer*, 20 Wall. 353, 368.* The injunction to the trial courts in both *A & P* and *Tri-Ergon* is the same: Do not judge the question of invention until you have first found, as matter of fact, whether in the novel conjunction the elements do or do not take on additional or different functions from being brought into concert. This is precisely what the master, in the instant case, failed to do.

In the *Tri-Ergon* case a claim for the association of a fly-wheel with the rotating shaft of a phonograph ap-

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* In *Powers-Kennedy Co.* v. *Concrete Co.*, 282 U. S. 175, 186, cited by *Hailes* v. *Van Wormer* in the *Tri-Ergon* case, the Court expressly defined the two types of cases to which the rule has been applied, and of which the *A & P* case and the *Tri-Ergon* are, respectively, examples.

paratus to secure uniformity of motion of a sound record on an elongated ribbon of inconsiderable mass, was invalidated (notwithstanding significant improvement following its use) on the finding that the fly-wheel in the patented conjunction performed only its customary function, to secure uniformity of motion, and nothing more. It was in that sense that the opinion in the *Tri-Ergon* case used the expression "involving no new principle, to produce an old result".

The test prescribed in the *Tri-Ergon* case was misapplied to the instant case because the Master erroneously assumed the underlying "principle" of the invention to be the narrow circumferential sealing zone spaced from the top of the "waist-line" shell (II, 653). In thus focusing on but one of the constituents of the novel combination, the Master failed to consider the undisputed fact that it is only because the gasket is locked-in and precompressed, and therefore unstretched and non-porous, that the concentrated pressure of the shell preserved by locating the narrow sealing zone at a distance below the top of the cap can mold the gasket into the irregularities of the glass surface to "effect a very strong frictional engagement with the vessel and form a very tight hermetic seal". His application of the test, therefore, did not touch upon the very thing that the *Tri-Ergon* case pointed to,—a consideration of the mode of operation and functional relation of *all* the constituents of the combination *acting in concert.*

The course of the Master's thinking as expressed in paragraph 105 is clear enough (II, 652-3). He did not follow the injunction of the *Tri-Ergon* case (or of *A & P*) to first find the objective facts as to the true principle or organic law of the novel combination, but rather, erroneously considering the Armstrong experiments as within the prior art, proceeded at once to the ultimate subjective conclusion that the difference between the Armstrong caps and the patented caps, or the transition from

the one to the other, was not invention.* In other words, without the precautionary guiding principles which are the distillation of a century and a half of experience with this elusive question in our courts,** the Master proceeded to his own "subjective opinion as to what seems an easy step and what does not"***—to a conclusion of obviousness when viewed after the event which this Court has so often warned is "not enough to negative invention."†

The Nature of the Master's Finding that Production of the Patented Caps Required No More Than Mechanical Skill. The next paragraph of the Master's report (106, II, 654) discloses clearly this course of his thoughts, and shows how significantly his ultimate conclusion of no invention was influenced by the erroneously considered Armstrong experiments. His conclusion was that:

> "the substitution by White of the sleeve-type gasket as here claimed, for the disk-type gasket of Armstrong, amounted to no more than the interchange of equivalents, well within the skill of one trained in the field, that did not rise to the level of invention."

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* We do not here discuss that ultimate question on its merits for two reasons. The Court of Appeals has now held that the master erred in considering the Armstrong experiments as part of the prior art; and in any case the purpose of this petition is not here and now to review the merits of that question, but to secure for petitioner an opportunity for full review of it on briefs and oral argument and against a background of recognition of the true principle or organic law of the patented closure caps.

** *Cf.* the comments in the *A & P* case, 340 U. S. at 151, and the remarks of Mr. Justice Brown in *McClain* v. *Ortmeyer* there cited.

*** Judge Learned Hand (C. C. A. 2) in *Kirsch* v. *Gould,* 6 F. 2d 793-794.

† *Goodyear* v. *Ray-O-Vac,* 321 U. S. 275, 279; and *Diamond* v. *Consolidated,* 220 U. S. 428 referred to in the *A & P* case in the footnote on p. 150 (340 U. S.).

It is important to note that he reached that conclusion as to "equivalents" despite the fact that, when dealing with the question of novelty, he had made findings of fact (based on oral testimony of witnesses whose demeanor he had opportunity to observe and on extensive experiments some of which were conducted in his presence and others testified to by defendant's fact witnesses and technical experts)* that:

> "Accordingly, although defendant has asserted the equivalence of the Armstrong and White closures, no satisfactory evidence has been offered by defendant as a basis of comparison of the resealing characteristics of these closures when subjected to the alleged complicating conditions [i. e. containing oily products, such as salad dressing, peanut butter and the like—II, 646] referred to in the patent in suit." (II, 647)

and (II, 647):

> "In view of the above, we are of the opinion that the defendant has not established that the Armstrong closure, as to which priority of conception over the claims of the patent in suit is conceded, will accomplish substantially the same result as does the closure of the patent in suit, in substantially the same way."

The Master attempted justification of this incongruity** by introducing a differentiation, new to the patent law so

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* II, 640-647, paragraphs [85] to [95].

** This incongruity in the specific findings of fact and conclusions of law was referred to in our brief in the Court of Appeals as a "paradox", somehow misleading that Court to think we were contending that a finding of novelty and a finding of no invention are inherently paradoxical, and to say "that contention had been settled adversely to the plaintiff" in the *A & P case.*

far as we know, between equivalency "for the purpose of the issue" of invention and for the purpose of the issue of novelty (II, 654); but what we particularly stress here is that the Master's finding of equivalency in the improperly considered Armstrong experiments, and his conclusion that consequently the production of the patented caps required no more than mechanical skill, were arrived at subjectively without a finding as to and without recognition of any objectively defined principle of the patented invention.

In conclusion, on this reason advanced for issuance of the writ, we submit that the need for a specific finding of fact as to the principle of the patented conjunction of elements before proceeding to judgment on the question of invention is clear in the instant case, and is likewise clear as a general matter of judicial procedure in this elusive and troublesome field.

B. The importance of a resolution by this Court of the now-existing judicial conflict and confusion as to whether, and what part of, the question of patentable invention in novel conjunctions of old elements is a question of fact of the sort reviewable only for clear error or is a question of law, or the sort of fact inference, subject to unrestricted review on appeal.

It would be supererogation, and therefore an imposition, for us to review here the recent opinions reflecting diversity of opinion on this "particularly troublesome" subject among the members of this Court* (Moore Fed-Pract., 2nd Ed., Vol. V, p. 2648). It is enough to note

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* *Goodyear* v. *Ray-O-Vac*, 321 U. S. 275; the two *Graver* v. *Linde* cases, 336 U. S. 271 and 339 U. S. 605; the *A & P* case, 340 U. S. 147 and *Trager* v. *Crest Specialty*, 341 U. S. 912.

that confusion in the lower courts persists.* It is also worthy of note that in many current decisions in the courts of appeal, and at least by implication in this Court** a distinction is drawn between findings contingent upon resolving conflicting testimony and conclusions deduced or inferred from uncontradicted testimony or undisputed documentary evidence, by whatever name these findings and conclusions may be called.

All apart from the desirability of resolving this conflict between the Courts of Appeals as to the scope of review of the ultimate issue of patentability, we suggest

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* For decisions since the *A & P* case holding that the conclusions of the lower court are binding on the reviewing court unless clearly erroneous, see *General Bronze Corp.* v. *Cupples Products Corp.* (CCA 8, 1951), 189 F. 2d 154, 158; *O'Brien* v. *O'Brien* (CCA 7, 1953), 202 F. 2d 254, 255-6, where the court recognized that this court in the *A & P* case may have freed the ultimate conclusion of invention from the fetters of Rule 52(a) but decided to adhere to the old rule until a more definite pronouncement is made by this Court; and see also the decision of the Sixth Circuit Court of Appeals in this case (II, 790).

For opinions holding the view that the *A & P* case gave the reviewing court freedom to pass on the ultimate issue of invention unfettered by Rule 52(a), see *Wabash Corp.* v. *Ross Electric Corp.* (CCA 2, 1951), 187 F. 2d 577, 579; *Packwood* v. *Briggs & Straton Corp.* (CCA 3, 1952), 195 F. 2d 971, 973; *United Mattress Mach. Co.* v. *Handy Button Mach. Co.* (CCA 3, 1953), 98 USPQ 296, 298; *Himes* v. *Chadwick* (CCA 9, 1952), 199 F. 2d 100, 102. See also decision of *Hanovia Chemical Co.* v. *David Buttrick Co.* (CCA 1, 1942), 127 F. 2d 888, decided before *A & P* case and subsequently receded from in *Bellavance* v. *Frank Morrow Co.* (CCA 1), 141 F. 2d 378 in light of *Goodyear* v. *Ray-O-Vac* decision, 321 U. S. 275, 279.

** See cases reviewed by *Moore*, Fed. Pract. 2nd Ed., Vol. V, pages 2637-2643; *Wabash Corp.* v. *Ross Electric Corp.* (CCA 2), 187 F. 2d 577, 597-604; *A & P* case, 340 U. S. at 153; *Deputy* v. *Du Pont*, 308 U. S. 488, 499.

that the old rule limiting the scope of review on this issue, (which persists in the Courts of Appeals of at least the Sixth, Seventh and Eighth Circuits in spite of this Court's decision in the *A & P* case) is fraught with dangerous consequences. This limitation tends to produce a superficiality of review on an issue which involves the application of the established criteria of invention to the objective facts, a subject of utmost importance in the administration of the patent law. This tendency manifests itself not only in cases where the patent is held invalid but equally in cases where the patent is held valid.

We suggest that the decisions of the Courts of Appeals in the *A & P* case (CCA 6), 179 F. 2d 636, rev. 340 U. S. 147, and in *Trager* v. *Crest Specialties Co.* (CCA 7), 184 F. 2d 577, rev. 341 U. S. 912, are illustrative of this trend in cases where the patent has been held valid, and we think the instant case is illustrative of this same trend in a case where the patent has been held invalid, as we have sought to demonstrate in our first point of argument.

We submit that this Court should declare itself unequivocally on this subject of conflict among Courts of Appeals in order to assure that the criteria of patentability fixed by this Court will be brought to bear in every case upon review of the ultimate issue of patentability.

C. The importance of requiring in cases involving claims for novel associations of old elements a finding of fact by the trial court as to the principle of the patented device and whether its constituent elements do or do not perform any additional or different function in the combination than they do out of it.

It is our submission that a most immediate and effective way of advancing and implementing the desirable analysis of the questions that underly the ultimate judgment of

invention, and of assuring adequate but not excessive review in accord with the purpose and intent of Rule 52(a), is for this Court now to exercise its authority in aid of such analysis by expressly declaring that it is the duty of the trial court to include in its findings of fact an express finding as to the true principle, mode of operation and functional relations of the patented conjunction of elements. We think it is clear that such a finding is an objective finding of fact subject to the limited review defined in Rule 52(a). We submit that by such findings a sharp line would be drawn at the point of danger in this elusive type of judgment and that the usefulness of the guiding (but never absolute) rules distilled from long experience would thereby be preserved and enhanced.

The courts and many eminent legal scholars have long sought to find an affirmative, objective rule.* No conclusive objective rule has been found. In seeking to diminish the deficiencies of subjective judgment after the event, the Courts have, however, developed and followed certain rational lines of approach which point the way to sound judicial determination of the question and narrow the gap that must finally be bridged by subjective judgment as to whether the patented thing was already within the available resources of skilled technicians.

The greatest difficulty has been encountered in dealings with new assemblies of old elements. Here the most useful guiding rule—although it is not an absolute one—has been the examination of the novel assembly to deter-

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* See footnote 5 to the opinion in the *A & P* case, (340 U. S. at p. 150), and Mr. Robinson's classic chapter "Of the Nature and Essential Attributes of an Invention," Robinson on Law of Patents, Volume I, pages 114, *et seq.* See also letter of Thomas Jefferson to Isaac McPherson, August 13, 1813, "The Writings of Thomas Jefferson", edited by H. A. Washington, Vol. VI.

mine whether, on the one hand, it is merely an intelligent choice of available tools and their successive application to the job in hand without the introduction of any new technological knowledge or effect; or whether, on the other hand, the new assembly is vitalized by a unique rule of its own existence which shows "that there is something in it, attribute or force, which did not exist before—something which is the law of its organization and function, and raises it above a mere aggregation of elements to a patentable combination." (*Diamond* v. *Consolidated,* 220 U. S. 428, 443.)

In its mature development, this guiding rule has been of great utility to both judges and counselors, having imparted a certain amount of stability and predictability to the law in this difficult field. It has, however, been recognized not to be a final objective test. At the end of the spectrum where mere "aggregation"* has been shown to exist, the novel assembly of old parts may possibly, although improbably, fall outside of the resources available to skilled technicians and within the scope of things which, as Jefferson put it (Footnote, *ante,* p. 27), "are worth to the public the embarrassment of an exclusive patent", and so may be found to display the quality of patentable invention.** At the other end of the spectrum, where true "combinations" lie, and the quality of invention is more often found, it may nevertheless be clear on the evidence submitted in the particular case that the new com-

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* For the sake of brevity we use the words "aggregation" and "combination" in the conventional sense of the patent law, notwithstanding the criticism from the point of view of ordinary speech expressed by Mr. Justice Jackson in the opinion in *Great Atlantic & Pacific Tea Corp.* v. *Supermarket Equipment Co.,* 340 U. S. 147, 151.

** A striking instance of this is the salt cellar case, *Westmoreland* v. *Hogan,* C. C. A. 3, 167 Fed. 327.

bination was already within the available resources of the skilled technician.*

It is, however, only reasonable, and it is well settled, that at the one end of the spectrum, where there is mere "aggregation," the burden is heavily on the patentee to show that what he did was beyond the skill of the art, as, for instance, by showing a "surprising", unexpected, or unpredictable result**; while at the other end of the spectrum, where in a true "combination" new knowledge‡ is found in the new mode of operation and technological results, the burden is heavily on the defendant to show by concrete evidence that the new knowledge was, in fact, within the immediately available resources of skilled technicians.***

In the instant case, petitioner has been denied the benefit of that initial presumption in the judicial consideration of the case by the absence of any finding of objective fact as to the existence or not, within the concert of elements,

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* Such cases have occurred, for instance, when the new association was shown to be in the immediate path of progress of an advancing art, or where the association, though never before made, was one that would suggest itself to a skilled mechanic as a necessary conclusion from his general knowledge and experience, as soon as the occasion arose.

** *A & P* case, *supra; McCord* v. *Beacon,* C. C. A. 1, 193 F. 2d 985, 989; *Packwood* v. *Briggs & Stratton,* 195 F. 2d 971, 973.

‡ In the instant case a new mode of application of the force applied (Robinson, Vol. I, pp. 148 and 365-6).

*** *Loom Co.* v. *Higgins,* 105 U. S. 580, 591; *Expanded Metal Co.* v. *Bradford,* 214 U. S. 366, 381; *Emery* v. *George H. Bowman* (CCA 6), 11 F. 2d 525, 526; *Hoeltke* v. *C. M. Kemp Mfg. Co.* (CCA 4), 80 F. 2d 912, 919; *Wine Ry. Appliance Co.* v. *Baltimore etc. Co.* (CCA 4), 78 F. 2d 312, 314.

of a new principle in the sense of a new mode of operation or a new functional relationship. Without such a finding, the Court of Appeals was in no position to apply the established guides to sound judicial determination of the ultimate issue.

The Fact Finding of the Court of Appeals Opinion Following Its Rejection of the Master's Consideration of the Armstrong Experiments

In our discussion of the Master's erroneous consideration of the unpublished Armstrong experiments and his diversion thereby to the ultimate question of invention we have not been unmindful of the fact that the Court of Appeals in its opinion (II, 791) concluded that the Master's error as to Armstrong "does not affect the soundness of the holding of lack of invention, which was based on other patents and practices besides that of Armstrong * * *. The use of the locked-in sleeve gasket and of the formation of the friction seal on a narrow area of the jar, at a distance below the top, particularly emphasized by plaintiff, were shown in various prior patents."

Again without entering upon a discussion on its merits of the ultimate question of invention, which we are now seeking a future opportunity to present fully to this Court on briefs and oral argument, we here submit that the excursion in the opinion of the Court of Appeals into the objective factual background of the case, absent any finding or concrete recognition of the principle of the invention, illustrates very well the need that such a finding should always be made by the trial court. Certainly, the findings in the opinion of the Court of Appeals as to the prior art were in no sense a concurrence with the findings of the Master. Indeed, the Court of Appeals opinion completely escapes the clear atmosphere of objective

facts that prevailed at the trial and is reflected in the Master's findings on the subject of novelty.

To support the statement that prior patents and practices show the "use of the locked-in sleeve gasket and of the friction seal on a narrow area of the jar, at a distance below the top" the opinion refers to the Anchor devices and the old White free-gasket caps (U. S. patent 1,807,187) and British patent 468,656, III, 17 and 104) as showing the type of sleeve gasket used in the patented closure caps, and correctly refers to our frank admission at the trial that if the gasket of the British patent were locked in it "would be the patent in suit." But, absent any finding on the subject, the opinion takes no note of the fact that the sealing principle of the old free-gasket caps was wholly antagonistic to the principle of the new locked-in-gasket caps. [Cf ante pages 13, 14.]

It was a basic concept of the old free-gasket caps that an air-tight seal was to be effected, and buckling of the cap and leakage through the seal prevented, by crowding the material of the free sleeve gasket up into the space between the upper side wall and top of the cap and the upper portion of the container to secure "a wide and very tight sealing zone between the vessel and the gasket" (III, 11, lines 40-42) and to assure that "the material in the angular portions of the closure about the rim of the container be quite solidly supported by the compressed gasket material * * * crowded and compacted about the mouth of the vessel in the angle between the top and side portions of the cap" (III, 11, lines 97-123). That is why a free gasket was used. When fixed gaskets were used, they were of a different kind, and acted on a principle different from that of the free gaskets and from that of the present invention.

In the new locked-in-gasket caps the principle was to conserve the resiliency of the wasteline of the cap, and to make maximum use of the moldability of the unstretched

precompressed gasket material, by excluding the gasket material entirely from the angle between the top and side portions of the cap, and to concentrate the resilient pressure thus preserved on a narrow sealing zone (patent in suit III, 4; second column, lines 23-66 and III, 5, first column, lines 48-64).

It was, we submit, the lack of any concrete finding as to the organic law of the patented closure caps that hid this difference of principle from the Court of Appeals and denied to petitioner any real judicial weighing of the evidence as to whether such a change was or was not within the then available resources of the skilled artisan.

The next patent referred to in the opinion of the Court of Appeals as showing "the use of the locked-in sleeve gasket and of the formation of the friction seal on a narrow area of the jar, at a distance below the top" is *Coale & Greensfelder*, 793,567 (II, 792) which was a chucked on cap, not a press-on cap, and would hardly be chosen as a source of knowledge of how to make most effective use for sealing and resealing of the inherent resilience of the waistline shell of a press-on cap. The finding of the master as to the *Coale & Greensfelder* cap (and a similar cap of the *Tolliver & Bellamy* patent 1,103,633—see II, 625-627 and 635) was—

> "Both patents indicate that it was contemplated that in the secured position on the container the closure would be held in place by pressing the lower portion of the skirt inwardly toward the center of the container, thus compressing the gasket material against the container. From what we find in the patents, the closures were not intended to seal the container by simply being pressed into a seated position by downward pressure alone, thereby providing a hermetic seal solely by means of friction between the surface of the container and the gasket (II, 635).

It seems clear that if the search of the prior art made in the opinion of the Court of Appeals, after it had corrected the Master's error in considering Armstrong as within the prior knowledge of the art, had been enlightened by a concrete finding of fact as to the true principle (mode of operation and organic functional relations) of the patented closure caps, it could have found none of it in *Coale & Greensfelder.*

The third and last of the "three prior disclosures" which were thought by the author of the opinion of the Court of Appeals to "teach formation of the friction seal on a narrow area of the jar at a distance from the top" (II, 792) is the patent to Schram 933,122. In this Schram patent there is indeed a narrow sealing zone at a distance from the top, but the sealing principle is the pressing of a stretched portion of a flat or washer type of gasket against the sharp edge of an annular bead formed on the neck of the container. The patent "did not contemplate a friction seal which the evidence establishes the closure of the patent in suit provides. Instead it was Schram's intention that his closure would be held in place by atmospheric pressure reinforced by a retaining clip, if the user so desired" (Master's Report, II, 633-634). In other words, it did not have the unstretched, pre-compressed sleeve gasket and was not a sealing and resealing press-on closure, but a vacuum closure incapable of resealing once the vacuum was broken by opening the container.

The fact is that the Patent Office passed on the question of invention in the light of the most pertinent prior art there was—the free pre-compressed sleeve gasket of the old White caps and this locked-in washer gasket of Schram, both in caps of the waistline type. It was this question that was passed on by the Board of Appeals (*ante*, p. 13), and none of the other patents and procedures of the prior

art presented at the trial added anything significant to this showing of the prior art considered by the Patent Office.

Respectfully submitted,

WILLIAM HAMMATT DAVIS,
GEORGE E. FAITHFULL,
CYRUS S. HAPGOOD,
RAYMOND L. GREIST,
PAUL PLUNKETT,
Attorneys for Petitioner.

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HAROLD B. WILLEY, C

IN THE

Supreme Court of the United States

OCTOBER TERM, 1953.

No. 341

WHITE CAP COMPANY,

Petitioner,

vs.

OWENS-ILLINOIS GLASS COMPANY,

Respondent.

BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT.

GEORGE I. HAIGHT
FRED E. FULLER
FRANK A. HARRINGTON
Attorneys for Respondent

The Scheffer Press, Inc.—ANdover 3-6850

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BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT.

TO THE HONORABLE THE CHIEF JUSTICE AND ASSOCIATE JUSTICES OF THE SUPREME COURT OF THE UNITED STATES:

OPINIONS BELOW.

The report of the Special Master and the Memorandum of the District Court approving and confirming the report of the Special Master and adopting the findings of the Special Master as the findings of the Court are unreported. The report of the Special Master appears on pages 601-760 of Volume II of the record and the District Court's Memorandum and Order and Judgment appear on pages 775-776 of Volume II of the record. The opinion of the Court of Appeals for the Sixth Circuit appears at pages 788-796 of Volume II of the record and is reported in 205 F. (2d) 694.

THE QUESTIONS PRESENTED.

The two questions presented by the petitioner (Pet. p. 7) do not arise from the record as will more fully appear from the argument herein. In the first question there is a factual assertion not supported by the record and the second question presented is moot because the Court of Appeals not only treated the findings of want of patentable invention as findings subject to the provisions of Rule 52(a) but made its own examination of the prior art and held the Master's findings supported on the record.

The only question presented by the petition is whether the Master, in finding that the patent in suit was invalid for want of invention, and the District Court and the Court of Appeals in a unanimous opinion in agreeing with that finding, so far departed from the accepted and usual course of judicial proceedings as to call for an exercise of this Court's power of supervision.

STATEMENT OF THE CASE.

On October 4, 1946, the complaint herein was filed charging respondent with infringement of United States Letters Patent No. 2,339,827 (R. III, 1) relating to "Closure Cap and Package." Respondent answered, setting forth among other defenses that the patent in suit was invalid over the prior art.

Proceedings were had before the Special Master appointed by the Court on December 1-5 and 8-10, 1947, and the Special Master filed his report (R. II, 601-760) on February 16, 1951, finding that each of the elements in the combination of the patent in suit was old and per-

formed the same mechanical function in the combination as it performed in the past outside the combination; that the patentee added nothing to the total stock of knowledge and that all his patent claims are invalid for want of invention; that the closure claimed involved no new principle not found in the prior art closures, particularly Armstrong, and recommended that the action be dismissed (R. II, 652-653, 742-743, 750).

On July 2, 1951, oral argument was had before the District Court and the District Court considered objections to the Master's report filed by both parties and briefs filed by both parties and the Court ordered the report of the Special Master approved and confirmed and adopted the findings of the Special Master as the findings of the Court (R. II, 775-776).

Appeal was taken to the United States Court of Appeals for the Sixth Circuit and argument was had on December 3, 1952, and on April 24, 1953, that Court filed a unanimous opinion affirming the judgment of the District Court (R. II, 787-796).

ARGUMENT.

This is an ordinary patent infringement case. The Master, the District Court and the Court of Appeals by unanimous decision all agreed that the patent in suit (on a simple bottle cap) is invalid for want of invention. The only question presented by the petition is whether in so agreeing the Master, the District Court and the Court of Appeals have so far departed from the accepted and usual course of judicial proceedings as to call for an exercise of this Court's power of supervision.

Petitioner's argument is that after making findings that the elements of the patent in suit were each old and each of the elements performed the same mechanical function in the combination as it performed in the past outside the combination, the Master did not make an additional finding "as to the existence or not, within the patented concert of elements, of a new principle, * * *" (Pet. p. 4). Further, petitioner complains, the Court of Appeals "did not note the omission (Pet. p. 5) of this finding and proceeded to treat the Master's further finding that the claimed invention required no more than mechanical skill as a finding subject to Rule 52 (a)." (Pet. p. 4).

Petitioner, however, is incorrect in both aspects of its argument. The Master made a finding concerning the existence within the patented combination of a "new principle", and the Court of Appeals not only noted the Master's findings but further found those findings supported on the record. The Master's report states (R. II, 652):

> "In summary, we find that each of the old elements claimed by the patent in suit performed the same

mechanical function in the combination claimed by White as it had performed in the past outside of that combination. Though here, as in the *Great Atlantic & Pacific* case, the results may have been more striking than in the past, White added nothing to the total stock of knowledge and all his claims are invalid for want of invention."

And the Master's report further states (R. II, 653):

"Here all of the elements of the patent in suit were concededly old. Furthermore, we are of the opinion that the closure claimed by White involved no new principle not found in prior art closures, particularly Armstrong."

While disagreeing with the Master and the District Court that Armstrong was a part of the prior art, the Court of Appeals held the Master's findings sound on the record. The Court of Appeals said (R. II, 791-792):

"But this conclusion that Armstrong was erroneously included in the pertinent prior art does not affect the soundness of the holding on lack of invention, which was based on other patents and practices besides that of Armstrong. The field was crowded, the patent in suit was an improvement patent, and every element in it was old. The use of the locked-in sleeve gasket and of the formation of the friction seal on a narrow area of the jar, at a distance below the top, particularly emphasized by plaintiff, were shown in various prior patents. We mention only a few of these in view of the exhaustive findings of the master. The sleeve gasket disclosed in plaintiff's closure was shown in the Anchor devices, in White, 1,807,187 and in White Cap British Patent, 468,656, prior to the patent in suit. The choice between different types of gaskets known to the art, as plaintiff's expert agreed, was for the ordinary mechanic. The substitution of the sleeve gasket for the disc gasket did not involve invention. *Dow Chemical Company* v. *Haliburton Oil Well Cementing Company*, 324 U. S. 320.

"In Coale & Greensfelder, No. 793,567, the 'packing-ring' (*i.e.* the lip of the gasket) is located, as the specifications state, 'at some distance below' the top of the cap. As to the White Cap British patent 468,656, plaintiff's counsel stated that 'if this gasket were locked in, it would be the patent in suit.' The specifications state that the upper end of the gasket 'is spaced a substantial distance from the top of the closure shell.' A similar feature is shown in Schram, 933,122. That is, these three prior disclosures teach formation of the friction seal on a narrow area of the jar at a distance from the top, the feature upon which the Board of Patent Appeals reversed the examiner's reiterated rejection of the application for the patent in suit. The Anchor cap has been on the market since 1916 and its style has never been changed. It is a side-seal closure and utilizes a locked-in gasket. Originally it was applied by a chuck. As a result the cap was injured upon removal so that it could not be resealed . When the press-on sealing machines were developed the Anchor cap was usable for resealing. Plaintiff's witness and vice president testified that the Anchor cap gives a 'perfect' seal and 'does a very good job of re-sealing.' The Anchor disclosure is clearly pertinent with reference to the asserted invention."

The soundness of the Court of Appeals' opinion with respect to prior use of sleeve gaskets is shown not only by the two of petitioner's own prior art patents to which the Court's opinion refers but also by the following:

Gilbert	39,643	1863	DX14*	(R.III,33; I,195)
Coale et al.	793,567	1905	DX17*	(R.III,49; I,195)
Lorenz	819,236	1906	DX18*	(R.III,53; I,195)
Taliaferro et al.	1,103,633	1914	DX20*	(R.III,65; I,195)
Hammer	1,244,496	1917	DX21*	(R.III,69; I,195)
Hammer	1,280,020	1918	DX22*	(R.III,73; I,195)
Deighton (British)	150,241	1920	DX26*	(R.III,101; I,196)
Daniel (Austrian)	90,219	1922	DX29*	(R.III,115; I,196)
Carvalho	1,413,257	1922	DX23*	(R.III,83; I,195)
Smith (Fig. 8)	1,476,472	1923	DX24*	(R.III,91; I,195)
White	1,590,787	1926	PX 2	(R.III,7; I, 38)
White	2,158,683	1939	DX143	(R.III,187; I,547)

Disc gaskets were also well known. For example, see

Schram	734,140	1903	DX16*	(R.III,45; I,195)
Schram	933,122	1909	DX19*	(R.III,59; I,195)
Tamura	1,575,464	1926	DX25*	(R.III,97; I,195)

The use of either form of gasket "locked in" the shell is also shown by those prior art patents. In the above tabulation, an asterisk following the Exhibit No. of the particular patent indicates the presence of that feature.

The Court of Appeals was also clearly correct in its holding that the formation of the friction seal on a narrow area of the jar at a distance from the top was old. As stated by the Court of Appeals the Coale & Greensfelder patent, No. 793,567 (R. III, 49, I, 195), discloses this feature, the specification stating (R. III, 51, col. 2, lines 65-67):

> "It will be observed that the packing-ring is located at some distance below the upper side of the cap * * *"

The second patent referred to by the Court of Appeals was the White British patent No. 468,656 (R. III, 104; I, 196). At the trial petitioner admitted that if the White British patent had the "locked-in gasket" "it would be the patent in suit", "it would be exactly like the patent in suit" (R. II, 473). Petitioner might also have admitted that the locked-in feature was not absent from this White British patent. The specification of that patent discloses that this feature may be used (R. III, 106, col. 2, 119-125). At the time the White British patent was applied for it was preferred that the gasket be not locked-in.

The Schram patent, No. 933,122 (R. III, 59; I, 195) also cited in the opinion of the Court of Appeals has all of the structure of representative Claim 2 of the patent in suit. While the drawings show a washer type of gasket this is not a patentable distinction. Further, the patent

says nothing in this regard except as it calls for "a packing gasket" in its Claims 1 to 4 and "a flexible gasket" in its Claims 5 to 8 (R. III, 63).

The Court of Appeals holding with respect to the Anchor caps is also soundly based on the record.

The Anchor caps are side seal closures (R. I, 46) with the sealing zone on the side of the glass considerably below the top surface as in the patent in suit (R. I, 46). As does the patent in suit, the Anchor cap utilizes the locked-in gasket (R. I, 138). Not only does the Anchor cap form what petitioner's witness George P. White, calls a "perfect" hermetic seal (R. I, 98) but also "does a very good job of re-sealing" in the words of the same witness (R. I, 138).

Because the principal problem of the side sealing closure was to develop a suitable machine for putting them on (R. II, 432) originally the Anchor cap was applied by a chuck (R. II, 431-432). Because of this method of applying, the cap was destroyed upon removal (R. I, 47). However, with the development of the press-on sealing machine the same cap described by petitioner's witness as a "very good cap" is used satisfactorily for sealing and resealing and does a "very good job of resealing" (R. II, 433; R. I, 138). So good is this cap that it has survived the test of the many years since 1916 (R. I, 98), and has supplanted the cap of the patent in suit at the Rochester and Canajahorie plants of Beechnut (R. I, 139, 151, R. II, 434).

Nor can petitioner undermine the concurrent holdings of the Master, the District Court and the Court of Appeals by changing its position with respect to what it claims as the "new result" of the combination in suit. Petitioner represents to this Court that "It is not the idea

of a narrow sealing zone in itself, but this particular structural combination that generates an effective seal in a narrow zone." (Pet. p. 12). Before the Master, however, petitioner urged, in attempting to distinguish a prior art reference which was conceded to be "exactly like the patent in suit if that gasket were locked in." (R. II, 473-474), that; "when you lock it in, it cannot go up, and you have a uniform, narrow, sealing surface; and that is what we think is invention, that narrow sealing surface, made uniform by locking the gasket in, and having the other two factors of the claims * * *"

The same position was taken by petitioner before the Patent Office Board of Appeals (See Plaintiff's Exhibit 4, pages 89-90, 122).

The judgment of invalidity for lack of invention is well supported on the record. The dismissal of the complaint was wholly justified for other reasons as well. Though not dealt with by the Court of Appeals, non-infringement by the accused structure is clear. Throughout its petition and brief petitioner stresses friction holding as a distinguishing characteristic of the patent in suit. For example, on page 21 of its petition, it is said that as a result of the construction of the patent in suit the top of the cap "can mold the gasket into the irregularities of the glass surface to 'effect a very strong frictional engagement with the vessel and form a very tight hermetic seal.' A similar statement is found on page 12. The "frictional gripping action" called for in the claims of the patent in suit is absent in the accused device. The accused closure rather than depending upon a gripping action is mechanically retained in its arrested position by a bead above a circumferential groove on the jar with which the accused caps are used (R. II, 413, *et seq.*).

CONCLUSION.

The Master's holding of invalidity is amply supported on the record. The District Court agreed. The affirmance by the Court of Appeals was wholly justified. The petition should be denied.

Respectfully submitted,

GEORGE I. HAIGHT,
FRED E. FULLER,
FRANK A. HARRINGTON,
Attorneys for Respondent.

End